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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------|----------------------------|------------------------|
| 10/660,063 | 09/11/2003 | Margaret A. R. Beynon | GB920020082US1 | 6190 |
| 7590 IBM Corporation IP Law Department 11400 Burnet Road Austin, TX 78758 | 06/26/2007 | | EXAMINER NUNEZ, JORDANY | |
| | | | ART UNIT 2179 | PAPER NUMBER |
| | | | MAIL DATE 06/26/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/660,063 | BEYNON ET AL. | |
| | Examiner | Art Unit | |
| | Jordany Núñez | 2179 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 May 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-31 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 29 is rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

Claim 29 is drawn to a computer program, per se. One of ordinary skill in the art would not read into the limitations of the claim hardware that would enable this claim to perform the steps recited. Therefore, this claims lack utility, as a computer program, per se, is not enabling in the absence of hardware.

Claim 29 is also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a credible asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the

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examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 7, 8, 13, 15-17, 21, 22, 27, 29-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Okada et al. (US7099867, hereinafter Okada) in view of Mandato et al (US20010025280, hereinafter Mandato).

As to claims 1, 15, 29-31:

Okada shows an apparatus, method, computer program, client and server for adding context to a chat transcript, comprising:

means for receiving a first message, defining at least a part of said chat transcript, from a user (column 4, lines 60-67);

means for analysing text of said first message (column 5, lines 1-6);

means, responsive to analysis of the text, for modifying said text to create a second message in order to add context thereto (column 7, lines 32-41);

and means for transmitting said second message to interested parties (figure 7, top).

Okada fails to specifically show: wherein the second message is different than the first message as defined by an alteration to the first message selected from the group consisting of an addition of text to the first message, a deletion of text from the first message, and a replacement of text in the first message.

In the same field of invention, Mandato teaches: a method of identifying a characteristic of a subscriber's device. Mandato further teaches: wherein the second message is different than the first message as defined by an alteration to the first message selected from the group consisting of an addition of text to the first message, a deletion of text from the first message, and a replacement of text in the first message (page 2, paragraph [0042]; page 3, paragraphs [0044] and [0046]).

Thus, it would have been obvious to one of ordinary skill in the art, having the teachings of Okada and Mandato at the time that the invention was made, to have combined the second message being different than the first message as defined by an alteration to the first message selected from the group

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consisting of an addition of text to the first message, a deletion of text from the first message, and a replacement of text in the first message of Mandato with the apparatus, method, computer program, client and server as taught by Okada.

One would have been motivated to make such combination because a way to improve user mobility and context awareness would have been obtained and desired, as expressly taught by Mandato (page 1, paragraph [0005], lines 10-14).

As to claims 2, 16, Okada shows:

wherein said means for modifying the text in order to add context thereto comprises: means for assigning (Examiner reads as –identifying--) a verb (e.g., patent, meeting) to the text (column 12, lines 27-34);

and means for associating the verb with the user from which the first message is received (column 4, lines 53-59).

As to claims 3, 17:

Okada and Mandato show an apparatus and method substantially as claimed, as specified above.

Okada further shows: wherein the means for assigning a verb to the text comprises: means for looking for matches between at least a portion of the text and at least one list (figure 3, element s212 and s222), each item in a list being associated with at least one **keyword** (column 4, lines 50-53), and means for selecting (e.g., by lowering by 1 degree) a verb associated with a matched item (column 12, lines 27-34).

Okada and Mandato fail to specifically show: each item in a list being associated with at least one **verb**.

It would have been obvious to one of ordinary skill in the art, having the teachings of Okada and Mandato at the time that the invention was made, to have included each item in a list being associated with at least one **verb** with the apparatus and method as taught by Okada.

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One would have been motivated to make such combination because a way to give a higher degree of importance to a verb to which the user frequently responds, and a lower degree of importance to a verb to which a user less frequently responds would have been obtained and desired, as inherently taught by Okada (column 4, lines 28-32).

As to claims 7, 21, Okada shows:

wherein said means for modifying the text in order to add context thereto comprises: means for defining how the text should be displayed at a client according to at least one predefined rule (column 7, lines 32-41).

As to claim 8, 22, Okada shows:

comprising: means for instructing said client how to display said text, based upon at least one predefined rule (column 7, lines 32-41).

As to claims 13, 27, Okada shows:

comprising: means for informing a user to whom the text belongs of the suggested context (column 7, lines 18-25);

means for receiving acceptance or rejection of said suggested context (column 7, lines 11-15); and means for acting upon said rejection or acceptance (column 7, lines 15-25).

Claims 4, 5, 18, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada in view of Mandato, further in view of Gruen et al. (US6393460, hereinafter Gruen).

As to claims 4, 5, 18, 19:

Okada and Mandato show an apparatus and method substantially as claimed, as specified above.

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Okada further shows: wherein associated verbs are assigned weightings which determine how often said verbs are assigned by said assigning means (column 12, lines 51-60)

Okada and Mandato fails to specifically show: wherein a plurality of verbs are associated with at least one item in at least one list.

In the same field of invention, Gruen teaches: a method and system of informing users of on-line chats subjects. Gruen further teaches: wherein a plurality of **keywords** are associated with at least one item in at least a list (column 6, lines 42-49).

Thus, it would have been obvious to one of ordinary skill in the art, having the teachings of Okada, Mandato and Gruen at the time that the invention was made, to have combined the plurality of **keywords** being associated with at least one item in at least a list of Gruen with the apparatus and method as taught by Okada and Mandato.

One would have been motivated to make such combination because a way to picking semantically meaningful words in the process of labeling chats, in spite of a potentially very large number of spelling mistakes, would have been obtained and desired, as expressly taught by Gruen (column 6, lines 42-49).

Claims 6, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada in view of Mandato, further in view Atkinson et al. (US6507726, hereinafter Atkinson).

As to claims 6, 20:

Okada and Mandato show an apparatus and method substantially as claimed, as specified above.

Okada further shows: the keyword may be visually displayed, in accordance with the degree of importance, in any of different colors and/or by different types of characters (column 7, lines 18-23).

Okada and Mandato fail to specifically show wherein the means for assigning a verb to the text comprises: means for replacing at least a portion of the text with said verb.

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In the same field of invention, Atkinson teaches: a computer implemented education system using chat rooms. Atkinson further teaches: wherein the means for assigning a verb to the text comprises: means for replacing at least a portion of the text with said verb (figure 11, "JackS says", "PamK asks", etc).

Thus, it would have been obvious to one of ordinary skill in the art, having the teachings of Okada, Mandato and Atkinson at the time that the invention was made, to have combined the means for assigning a verb to the text comprises: means for replacing at least a portion of the text with said verb of Atkinson with the apparatus and method as taught by Okada and Mandato.

One would have been motivated to make such combination because a way to contribute collateral curricula materials to primary curricula available would have been obtained and desired, as expressly taught by Atkinson (column 1, lines 28-30).

Claims 9, 10, 14, 23, 24, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada in view of Mandato, further in view of Kurlander (US6069622)

As to claim 9, 10, 14, 23, 24, 28:

Okada and Mandato show an apparatus and method substantially as claimed, as specified above.

Okada further shows: an IRC window is displayed may be modified to indicate the occurrence of the keyword (e.g., assigning context based on a predetermined theme) (column 7, lines 26-28).

Okada and Mandato fail to specifically show: comprising means for a user to indicate their mood, means for using said indicated mood to influence the context added to said text, means for including an adverb as part of said context, said adverb chosen according to the mood indicated by the user, and comprising means for assigning context based on a predetermined theme.

In the same field of invention, Kurlander teaches: comic panel generation based on input of text. Kurlander further teaches: comprising means for a user to indicate their mood (column 9, lines 47-52), means for using said indicated mood to influence the context added to said text (column 9, lines 54-56),

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means for including an adverb as part of said context, said adverb chosen according to the mood indicated by the user (column 10, lines 26-32), and a male character stating that he is from Ohio, the word "Ohio" being a predefined trigger word, and a system modifying the background to show a map of Ohio (e.g., assigning context based on a predetermined theme) (column 8, lines 47-51).

Thus, it would have been obvious to one of ordinary skill in the art, having the teachings of Okada, Mandato and Kurlander at the time that the invention was made, to have combined the comprising means for a user to indicate their mood, means for using said indicated mood to influence the context added to said text, and means for including an adverb as part of said context, said adverb chosen according to the mood indicated by the user of Kurlander with the apparatus and method as taught by Okada and Mandato.

One would have been motivated to make such combination because a way to aid a user gain a complete picture of a chat session would have been obtained and desired, as expressly taught by Kurlander (column 2, lines 14-16).

Claims 11, 12, 25, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada in view of Mandato, further in view of Miyashita (US20030154250).

As to claims 11, 12, 25, 26:

Okada and Mandato show an apparatus and method substantially as claimed, as specified above.

Okada and Mandato fail to specifically show: comprising means for storing a history of the chat transcript and comprising means for updating said stored chat transcript; means for reflecting any changes in said transcript on the display screens of users involved in the chat.

In the same field of invention, Miyashita teaches: a client computer displaying chat log data. Miyashita further teaches: comprising means for storing a history of the chat transcript (page 4, paragraph [0060]) and comprising means for updating said stored chat transcript (page 4, paragraph [0070]); means for reflecting any changes in said transcript on the display screens of users involved in the chat (page 4, paragraph [0072]).

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Thus, it would have been obvious to one of ordinary skill in the art, having the teachings of Okada, Mandato and Miyashita at the time that the invention was made, to have combined the comprising means for storing a history of the chat transcript and comprising means for updating said stored chat transcript; means for reflecting any changes in said transcript on the display screens of users involved in the chat of Miyashita with the apparatus and method as taught by Okada and Mandato.

One would have been motivated to make such combination because a way to enable a plurality of users to communicate with one another more smoothly would have been obtained and desired, as expressly taught by Miyashita (page 1, paragraph [0006]).

References to specific columns, figures or lines should not be limiting in any way. The entire reference provides disclosure related to the claimed invention.

Response to Arguments

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, Applicant's arguments with respect to above claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Rafal et al. [US20020002586]

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordany Núñez whose telephone number is (571)272-2753. The examiner can normally be reached on Monday Through Thursday 9am-7:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571)272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JN
6/18/2007


WEILUN LO
SUPERVISORY PATENT EXAMINER